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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,402

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EXAMINER

SAUNDERS JR, JOSEPH

ART UNIT

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2614

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,402	<b>Applicant(s)</b> OBATA ET AL.	
	<b>Examiner</b> Joseph Saunders	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8-11-08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This office action is in response to the communications filed July 25, 2008.

Claims 1 – 14 are currently pending and considered below.

#### ***Claim Rejections - 35 USC § 112***

2. Claims 1 – 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The term "downward orientation", in claim 1 is a relative term which renders the claim indefinite. The term "downward orientation" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Since the claim language does not provide a clear reference point to distinguish the "downward orientation", there is no way of determining what constitutes "downward orientation".

4. Claim 10 and 11 recites the limitation "external connection terminal". There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 3, 7 – 9, and 12 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pua et al. (US 6,490,163), hereinafter Pua, in view of Liu et al. (US 6,567,273), hereinafter Liu, and Peiker et al. (US 5,638,455), hereinafter Peiker.

**Claim 1:** Pua discloses an audio recording device (portable data storage device) which is provided with a microphone sound collection means (microphone 14), and a connection terminal (serial bus port 17 with pins 174) to connect to an external device (USB port 21 of a computer 2), the audio recording device comprising: a first casing (body 1) having a front side (e.g., side with indicator light 42) and a rear side opposite the front side (e.g., side opposite side with indicator light 42), and a second casing (housing 173); wherein a first end portion of the second casing is rotatably joined to a lower first end portion of the first casing (Figures 6 – 8), and wherein the connection terminal is protrudingly provided on a second end portion of the second casing (Figures 6 – 8 show the unshaded portion of pins 174, responsible for making the electrical connection by protruding into USB port of the computer 2, located at the end portion of the housing 173).

Pua does not disclose that the second casing can be folded and stored on the rear side of the first casing and further does not disclose wherein the microphone is located at a second end portion of the first casing, opposite to the first end thereof. Pua further does not disclose wherein the position of the second casing can be fixed at predetermined angle intervals or at any angle with respect to the first casing, and

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wherein the audio recording device can be placed with the second casing being in a downward orientation and the first casing tilting toward the connection terminal

Liu discloses a similar way of rotatably joining a first casing (card 200) to a second casing (USB plug 202) in Figure 4. Liu goes on to teach that a USB plug 302 can also be designed to rotate in a vertical plane out of card 300 as illustrated in Figure 5. Therefore, given the teachings of Liu that “the USB plugs of FIGS. 1 – 5 can be moved out by pushing, rotating in a horizontal plane, or rotating in a vertical plane,” Column 5 Lines 20 – 65, it would have been obvious to one of ordinary skill in the art to modify the horizontal rotating design of Pua to be a vertical rotating design as taught by Liu, since both designs allow for a USB port to be easily positioned and convenient in use. Further, the design of Liu also affords the advantage that the USB port is received in a corresponding slot without influencing the size and appearance of the first housing or body of the device. Pua and Liu do not disclose to choose the rear side to fold and store the second casing, however there are only two sides to the device of Liu and the front side of a device typically have operating buttons placed or an indicator light 42. Therefore, given that there are only two possibilities and folding into the front side may possibly be more difficult due to the placement of operating buttons or block the indicator light, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose the rear side.

Finally, Peiker teaches a microphone (microphone 14) and a connection terminal to connect to an external device (cable connection 8); the audio recording device comprising: a first casing (upper half-shell 2) having a front side (front side 4) and a rear

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side opposite the front side (inner surface 12), and a second casing (lower half-shell 1); wherein a first end portion of the second casing is rotatably joined (via hinge axis 3) to a first end portion of the first casing (Figure 1); wherein the microphone is located at a second end portion of the first casing opposite to the first end thereof (microphone 14 is located opposite hinge axis 3, achieving "good height starting from the base," and this is advantageous when used as a desk microphone due to the upward angle, Column 1 Lines 40 – 57); wherein the connection terminal is protrudingly provided on the second casing (Figure 1); wherein the position of the casing can be fixed at predetermined intervals or at any angle with respect to the first casing ("the hinge is arranged concealed. Preferably, it is designed so that upper half-shell 2 is locked in place, on the one side, in open end position, on the other side, in closed end position. Instead of two, three or more positions can also be provided," Column 3 Lines 1 – 5, and "The device can, of course have other comfort features, such as, e.g., a locking in the folded-up position to avoid an unintentional unfolding, a spring mechanism, which holds the upper half-shell in unfolded position, etc.," Column 4 Lines 10 – 17); and wherein the audio recording device can be placed with the second casing being in a downward orientation and the first casing tilting toward the connection terminal (Figure 1). Therefore, given the similarity between the invention of Pua and Liu and the invention of Peiker, it would have been obvious to one of ordinary skill in the art at the time of the invention to locate the microphone at the second end portion of the first casing and include the ability to fix the device at different angles thereby allowing for the "comfort features" and other aforementioned advantageous taught by Peiker.

**Claim 2:** Pua, Liu, and Peiker disclose the audio recording device according to claim 1, comprising a recessed portion (slot 308 in Figure 5 of Liu), into which the connection terminal is fitted (USB plug 302), formed from a raised portion on the rear side of the first casing (“raised portion” surrounds slot 308 in Figure 5) (See also housing lobe 6 of Peiker).

**Claim 3:** Pua, Liu, and Peiker disclose the audio recording device according to claim 2, wherein a front end portion of the connection terminal is covered by a wall of the recessed portion when the second casing is in a folded and stored state (“wall” is illustrated in Figure 5 of Liu since the end portion of 302 is illustrated with dotted lines to show it is hidden) (See also housing lobe 6 of Peiker).

**Claims 7 – 9** are substantially similar in scope to claim 1 – 3 respectfully and therefore is rejected for the same reasons.

**Claim 12:** Pua, Liu, and Peiker disclose the audio recording device according to claim 7, comprising a display on the front side of the first casing (indicator light 42, Pua).

**Claim 13:** Pua, Liu, and Peiker disclose the audio recording device according to claim 8, comprising a loudspeaker on the rear side of the first casing between the second end

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of the first casing and the connection terminal when the first and second casings are folded together (speaker frame 13, Peiker).

**Claim 14:** Pua, Liu, and Peiker disclose the audio recording device according to claim 13, wherein the rear side of the first casing adjacent the second end of the first casing and a surface of the second casing are aligned when the first and second casings are folded together (Figure 5 of Liu and Figure 1 of Peiker).

7. Claims 4 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pua, Liu, and Peiker in view of Ma (US 5,691,882), hereinafter Ma.

**Claim 4:** Pua, Liu, and Peiker disclose the audio recording device according to any of claim 1, but do not disclose comprising a supporting member, which abuts the connection terminal, provided on the rear side of the first casing.

Ma discloses a similar terminal folded into a housing 1 and teaches two half-round clamping plates 13 provided on the rear side of housing 1 support the connection terminal by securing the terminal in the recess. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a supporting member of clamping plates 13 as disclosed by Ma in the invention of Pua, Liu, and Peiker to retain the terminal in a secure position when not in use.



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**Claims 5 and 6** are substantially similar in scope to claim 4 and therefore are rejected for the same reasons.

8. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pua, Liu, and Peiker in view of Matsuda (EP 1 139 540 A1), hereinafter Matsuda.

**Claim 10:** Pua, Liu, and Peiker disclose the audio recording device according to claim 8, but do not disclose wherein a thickness of the external connection terminal is thinner than a thickness of the second casing, and comprising a supporting member, which abuts the connection terminal, provided on the rear side of the first casing, whereby, when a strong force is applied to the external connection terminal towards the first casing damage or deformation to the external connection terminal is prevented by the supporting member. Matsuda discloses a similar terminal folded into a housing 1 and teaches wherein a thickness of the external connection terminal is thinner (recess 8 of the plug 3 Figure 4) than a thickness of the second casing (area peripheral to recess 8), and comprising a supporting member (block 10a), which abuts the connection terminal, provided on the rear side of the first casing (housing 1), whereby, when a strong force is applied to the external connection terminal towards the first casing damage or deformation to the external connection terminal is prevented by the supporting member (Since block 10a is under the connection terminal and supporting the connection terminal in the closed position and no space is provided between the connection terminal and block 10a deformation is prevented since there is no possibility of further

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downward movement). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a supporting member of block 10a as disclosed by Matsuda in the invention of Pua, Liu, and Peiker to retain the terminal in a secure position when in the upright position.

**Claim 10:** Pua, Liu, Peiker, and Matsuda disclose the audio recording device according to claim 10, wherein the support member comprises a bottom portion of the recessed portion formed in a step shape, raising the side of the external connection terminal (plug locker 4, Figure 9 of Matsuda).

### ***Response to Arguments***

9. Applicant's arguments with respect to claim 1 – 14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Saunders whose telephone number is (571) 270-1063. The examiner can normally be reached on Monday - Thursday, 9:00 a.m. - 4:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. S./

Examiner, Art Unit 2614

/CURTIS KUNTZ/

Supervisory Patent Examiner, Art Unit 2614